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OFFICE OF PETITIONS

In re Application of :
Buck et al. :
Application Number: 10/590879 : ON PETITION
Filing Date: 08/27/2006 :
Attorney Docket Number: :
21381/0212121-USO :

This is a decision on the petition to revive the above-application under 37 CFR 1.137(b)¹ filed on July 2, 2009. This is also a decision on the "Request for Reconsideration of Holding of Abandonment", filed on July 6, 2009.

The renewed petition to withdraw the holding of abandonment is again **DISMISSED**.

The petition under 37 CFR 1.137(b) is **GRANTED**.

This application became abandoned on January 24, 2009, for failure to timely submit the issue and publication fees in response to the Notice of Allowance and Fee(s) Due mailed on October 23, 2008, which set a three (3) month statutory period for reply. Notice of Abandonment was mailed on February 18, 2009. On March 26, 2009, a petition to withdraw the holding of

¹ Effective December 1, 1997, the provisions of 37 CFR 1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition filed under the provisions of 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application.

In a nonprovisional application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof. In an application abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

(2) the petition fee as set forth in 37 CFR 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Director may required additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

abandonment was filed. On May 5, 2009, the petition was dismissed.

On July 2, 2009, the subject petition under 37 CFR 1.137(b) was filed. On July 6, 2009, the "Request for Reconsideration of Holding of Abandonment" was filed.

PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

Petitioner requests reconsideration of the decision on petition mailed on May 5, 2009. Accordingly, the petition will first be treated as a renewed petition to withdraw the holding of abandonment.

Petitioner's counsel asserts again that the holding of abandonment should be withdrawn. Specifically, petitioner asserts:

The fact, as stated in the petition, is that whilst the Notice of Allowance dated 23 October 2008 was indeed received it was not received, as immediately notified the Patent and Trademark Office by the attorney's letter of 5 March 2009, *until 5 March 2009*. That does not necessarily imply any irregularity in the mailing of the Notice by the Office. But irregularity clearly occurred during the interval spanning the time the Notice left the Office and the day of its receipt by the undersigned attorney. Neither the Patent Office nor the attorney had any control over the Notice. Since the Notice was received the rules requiring that a petitioner "must state that the Office Action was not received at the correspondence address of record, and that a search of the practitioner's record, including any file jacket or the equivalent, and the application contents, indicates that the Office action was not received" do not apply in the instant case. In paragraph 3 of his Petition, the Practitioner did describe his system used for recording incoming Office actions.

(emphasis in original)

A review of the record indicates no irregularity in the mailing of the Notice mailed on October 23, 2008, and in the absence of any irregularity in the mailing, there is a strong presumption that the Notice was properly mailed to the address of record.

This presumption may be overcome by a showing that the Notice was not in fact received.

MPEP 711.03(c) states:

In Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of Delgar, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of Delgar is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133).

To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner describing the system used for recording an Office action received at the correspondence address of record with the USPTO. The statement should establish that the docketing system is sufficiently reliable. It is expected that the record would include, but not be limited to, the application number, attorney docket number, the mail date of the Office action and the due date for the response.

Practitioner must state that the Office action was not received at the correspondence address of record, and that a search of the practitioner's record(s), including any file jacket or the equivalent, and the application contents, indicates that the Office action was not received. A copy of the record(s) used by the practitioner where the non-received Office action would have been entered had it been received is required.

A copy of the practitioner's record(s) required to show non-receipt of the Office action should include the master docket for the firm. That is, if a three month

period for reply was set in the nonreceived Office action, a copy of the master docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. If no such master docket exists, the practitioner should so state and provide other evidence such as, but not limited to, the following: the application file jacket; incoming mail log; calendar; reminder system; or the individual docket record for the application in question.

The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).

(emphasis added)

Petitioner again asserts that the Notice was not received until March 5, 2009.

While petitioner did include a statement describing the system used for recording an Office action received at the correspondence address, no documentary proof that the Office action was not timely received was provided. MPEP 711.03(c), states, in pertinent part, that a copy of the record(s) used by the practitioner where the non-received Office action would have been entered had it been timely received is required. In this case, as petitioner asserts that the Office action was received, but was not timely received, a copy of the docket record, including the master docket for the firm, showing where the Notice of Allowance would have been entered had it been received when mailed on October 23, 2008 is required. In the absence of the presentation of said documentary evidence, petitioner has not provided a sufficient showing that the Notice of Allowance was not timely received.

As petitioner has not provided a sufficient showing of non-receipt of the Notice of Allowance mailed on March 23, 2008, the petition is again dismissed.

PETITION UNDER 37 CFR 1.137(b)

Receipt of the issue and publication fees is acknowledged.

It is not apparent whether the person signing the statement of unintentional delay was in a position to have firsthand or direct knowledge of the facts and circumstances of the delay at issue. Nevertheless, such statement is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay.² In the event that such an inquiry has not been made, petitioner must make such an inquiry. If such inquiry results in the discovery that it is not correct that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, petitioner must notify the Office.

The application is referred to the Office of Data Management for processing into a patent.

Telephone inquiries related to this decision should be directed to the undersigned at 571-272-3231.



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² See 37 CFR 10.18(b) and Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53178 (October 10, 1997), 1208 Off. Gaz. Pat. Office 63, 103 (October 21, 1997).